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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/007,108	11/12/2001	Jay S. Walker	97-051-C1	6408

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EXAMINER

MYHRE, JAMES W

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 11/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/007,108

Applicant(s)

WALKER ET AL.

Examiner

James W Myhre

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 68-77 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 72-74 is/are allowed.
- 6) ☒ Claim(s) 68-71, 75, and 76 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 23, 2004 has been entered.

Response to Amendment

2. The amendment filed on August 23, 2004 has been considered but is ineffective to overcome the Kravitz (6,029,150) reference. The amendment canceled Claims 27-29 and added new Claims 75-77. Therefore, the currently pending claims considered below are Claims 68-77.

Double Patenting

3. The amendment filed on August 23, 2004 has overcome the rejection of Claims 27-29 and 68-74 under obvious-type double patenting in paragraph 2 of the May 20, 2004 Office Action by canceling Claims 27-29 and filing a Terminal Disclaimer. Therefore, the Examiner hereby withdraws that rejection.

Claim Rejections - 35 USC § 112

4. The amendment filed on August 23, 2004 amended Claim 73 to overcome the 35 U.S.C. 112, second paragraph, rejection of this claim in paragraphs 4-6 of the May 20, 2004 Office Action for insufficient antecedent basis of one of the features in the claim. Therefore, the Examiner hereby withdraws that rejection.

Claim Rejections - 35 USC § 101

5. The amendment filed on August 23, 2004 amended Claim 68 to include the limitation that the order data was being received over an electronic network, thereby overcoming the 35 U.S.C. 101 rejection in paragraph 8 of the May 20, 2004 Office Action. Therefore, the Examiner hereby withdraws that rejection.

Claim Objections

6. Claim 76 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 76 is an apparatus claim which is dependent upon (refers back to) the independent method Claim 72. The claim incorporates the exact same steps of the parent claim without placing further limitations thereon. The Applicant may overcome this objection by incorporating the actual steps performed in Claim 72 into the appropriate devices within the apparatus claim, i.e. rewriting Claim 76 in independent form.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 68-71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kravitz(6,029,150).

Claims 68, 70, and 71: Kravitz discloses a method for processing payment for a sale of goods in which a remote merchant receives an order from a customer, determines a total price for the order, and transmits the order data back to the customer; the customer arranges (full) payment for the order with his local agent; the remote merchant receives notification of the (full) payment receipt; the goods are then shipped to the customer; and the payment is transferred to the remote seller's account (col 7, line 12 – col 10, line 60). While Kravitz does not disclose that the local agent is a local seller (e.g. another merchant), the present claims do not include any transaction being completed with the local seller, thus, little patentable weight is given to the other fields of endeavor in which the payment receiver may be engaged. Furthermore, in the specification the Applicant defines the local seller (local POS system) as "As used herein, the term "POS system" includes a conventional point-of-sale processing system, an ATM machine, and any other appropriate system for receiving and processing financial payment from customers" (page 9, lines 247-249). Therefore, it would have

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been obvious to one having ordinary skill in the art at the time the invention was made that the agent could also be the local POS system (e.g. local seller or ATM machine). One would have been motivated to use a local seller as the agent in Kravitz in order to have a ready-made extensive network of agents, thus eliminating the need to set up an additional system of agents throughout the country.

Claim 69: Kravitz discloses a method for processing a payment for a sale of goods as in Claim 68 above, and further discloses that the order data includes at least the price of the order and order number (col 7, line 12 – col 10, line 60).

Allowable Subject Matter

9. Claims 72-77 contain allowable subject matter.

Statement of Reasons for the indication of Allowable Subject Matter

10. The following is a statement of reasons for the indication of allowable subject matter:

Prior art was found which disclosed receiving a code relating to an order from a remote seller, ascertaining the price of the order from the code, locally receiving payment in full for the order, and forwarding at least a portion of the payment to the remote seller (Kravitz). Prior art could not be found which disclosed that the code relating to the order was in a bar code format that was scanned in locally and used to identify that the order was a remote order.

Response to Arguments

11. Applicant's arguments filed August 23, 2004 have been fully considered but they are not persuasive.

a. The Applicant argues that Kravitz does not disclose how any single entity would perform the four steps of Claim 68 (page8). However, the Examiner notes that Claim 68 does not include any limitations that the steps are being perform by a single entity. The claim merely recites four steps that are being performed in the method. These same four steps are being performed by the Kravitz system.

b. The Applicant also argues against the previous office action giving little patentable weight to the other fields of endeavors that the payment receiver may or may not be engaged in (page 8). As pointed out in the previous rejection and again in the above rejection of Claim 68, the Applicant has identified the local seller (local POS system) as including "a conventional point-of-sale system, an ATM machine, and any other appropriate system for receiving and processing financial payment from customers" (page 9, lines 247-249). Since the agent in Kravitz is receiving and processing a financial payment from the customer, it is encompassed within the Applicant's definition of a second seller (POS system). Furthermore, as also argued in the rejection of Claim 68, while the Applicant is calling this payment receiving entity a "second seller", it is not disclosed nor claimed that this entity is in fact selling anything. Therefore, no weight is afforded to the name given to the entity by the Applicant.

c. The Applicant argues against the Examiner's interpretation of 35 U.S.C. 112, sixth paragraph, as pertaining only to means-plus-function claims in paragraph 13c of

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the May 20, 2004 Office Action. The Examiner has reviewed the appropriate parts of the MPEP and agrees that this paragraph also encompasses step-plus-function claims. The Examiner notes that such "step-plus-function" claims are very rare and could not find anyone within the Office who had actually seen one before. Furthermore, in view of the fact that these claims were indicated as containing allowable subject matter in the last Office Action (and again above), the Examiner is unsure of what the Applicant is requesting. The Examiner has already interpreted the "step for scanning a barcode" as actually scanning a barcode, and so forth for the remaining steps. In other words, the claims were interpreted as performing functions, without interpreting the actual acts involved in performing that function. For example, the step for scanning a barcode could be performed using a variety of different steps. The barcode could be passed in front of a stationary barcode reader, or the barcode could be placed on a flat surface and a portable barcode reader could be used to scan the barcode by moving the portable barcode readers across the barcode. Since the specification did not disclose the exact acts used in scanning the barcode, such as step is broadly interpreted to include any method (series of acts) for performing the function of scanning a barcode. If the Applicant believes that specific acts for performing the claimed steps are delineated within the specification, the Examiner requests the Applicant specifically identify the location of such disclosure as per MPEP 2181.

Conclusion

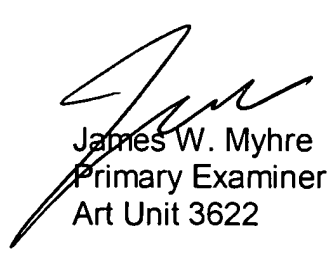
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (703) 308-7843. The examiner can normally be reached Monday through Thursday from 6:30 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (703) 305-8469. The fax phone number for Formal or Official faxes to Technology Center 3600 is (703) 872-9306. Draft or Informal faxes, which will not be entered in the application, may be submitted directly to the examiner at (703) 746-5544.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (703) 308-1113.


JWM

October 29, 2004


James W. Myhre
Primary Examiner
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